

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

66/07/11



| RECEIPT NUMBER |  | ANTICIPATED CLASSIFICATION OF THIS APPLICATION: |          | PRIOR APPLICATION |          |
|----------------|--|---|----------|-------------------|----------|
|                |  | CLASS   | SUBCLASS | EXAMINER          | ART UNIT |
| 12344.2USC1    |  |   |          | F. POINVIL        | 2761     |

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EL455018055US  
Date of Deposit: November 10, 1999

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By: Linda McCormick  
Name: Linda McCormick

AA

JCS 42 U.S.P.T.O.  
09/09/99  
11/10/99

CONTINUATION APPLICATION UNDER 37 C.F.R. § 1.53(b)

BOX PATENT APPLICATION  
Assistant Commissioner for Patents  
Washington, DC 20231

Dear Sir:

This is a request for filing a continuation application under 37 CFR § 1.53(b) of Serial No. 08/539,413, filed on October 5, 1995 entitled METHOD AND SYSTEM FOR GENERATING STATISTICALLY-BASED MEDICAL PROVIDER UTILIZATION PROFILES by the following inventor(s):

|                          |  |                                  |  |
|--------------------------|--|----------------------------------|--|
| Full Name<br>Of Inventor | Family Name<br>SEARE                                 | First Given Name<br>JERRY        | Second Given Name<br>G.                    |
| Residence & Citizenship  | City<br>SALT LAKE CITY                               | State or Foreign Country<br>UTAH | Country of Citizenship<br>USA              |
| Post Office Address      | Post Office Address<br>1609 EAST 900 SOUTH           | City<br>SALT LAKE CITY           | State & Zip Code/Country<br>UTAH 84105/USA |
| Full Name<br>Of Inventor | Family Name<br>SMITH-WILSON                          | First Given Name<br>PATRICIA     | Second Given Name                          |
| Residence & Citizenship  | City<br>NORTH SALT LAKE                              | State or Foreign Country<br>UTAH | Country of Citizenship<br>USA              |
| Post Office Address      | Post Office Address<br>850 NORTH HIGHWAY 89          | City<br>NORTH SALT LAKE          | State & Zip Code/Country<br>UTAH 84054/USA |
| Full Name<br>Of Inventor | Family Name<br>VANWAGONER                            | First Given Name<br>KURT         | Second Given Name                          |
| Residence & Citizenship  | City<br>LAYTON                                       | State or Foreign Country<br>UTAH | Country of Citizenship<br>USA              |
| Post Office Address      | Post Office Address<br>294 SOUTH FLINT STREET        | City<br>LAYTON                   | State & Zip Code/Country<br>UTAH 84041/USA |
| Full Name<br>Of Inventor | Family Name<br>MATTEY                                | First Given Name<br>JEAN         | Second Given Name<br>A.                    |
| Residence & Citizenship  | City<br>MIDVALE                                      | State or Foreign Country<br>UTAH | Country of Citizenship<br>USA              |
| Post Office Address      | Post Office Address<br>955 EAST CREEK HILL LANE, #20 | City<br>MIDVALE                  | State & Zip Code/Country<br>UTAH 84047/USA |

|  |   |   |   |
|--|---|---|---|
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>SNYDER                          | <b>First Given Name</b><br>EILEEN       | <b>Second Given Name</b><br>K.                        |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>SANDY                                  | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>1390 SANDY HILLS DRIVE  | <b>City</b><br>SANDY                    | <b>State &amp; Zip Code/Country</b><br>UTAH 84093/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>WAHLSTROM                       | <b>First Given Name</b><br>CANDANCE     | <b>Second Given Name</b>                              |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>SALT LAKE CITY                         | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>41 WEST GIRARD AVENUE   | <b>City</b><br>SALT LAKE CITY           | <b>State &amp; Zip Code/Country</b><br>UTAH 84103/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>WILLIS                          | <b>First Given Name</b><br>MICHELLE     | <b>Second Given Name</b>                              |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>SANDY                                  | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>458 EAST 10375 SOUTH    | <b>City</b><br>SANDY                    | <b>State &amp; Zip Code/Country</b><br>UTAH 84070/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>BENTLEY                         | <b>First Given Name</b><br>MATTHEW      | <b>Second Given Name</b><br>R.                        |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>WEST JORDAN                            | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>7165 SOUTH CALLIE DRIVE | <b>City</b><br>WEST JORDAN              | <b>State &amp; Zip Code/Country</b><br>UTAH 84084/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>WENZBAUER                       | <b>First Given Name</b><br>STEVEN       | <b>Second Given Name</b><br>J.                        |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>BOUNTIFUL                              | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>209 WEST 3500S          | <b>City</b><br>BOUNTIFUL                | <b>State &amp; Zip Code/Country</b><br>UTAH 84010/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>FREDETTE                        | <b>First Given Name</b><br>RODNEY       | <b>Second Given Name</b>                              |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>SALT LAKE CITY                         | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>2212 EAST 2700 SOUTH    | <b>City</b><br>SALT LAKE CITY           | <b>State &amp; Zip Code/Country</b><br>UTAH 84109/USA |
| <b>Full Name<br/>Of Inventor</b>       | <b>Family Name</b><br>SENNETT                         | <b>First Given Name</b><br>VICKI        | <b>Second Given Name</b><br>SUE                       |
| <b>Residence<br/>&amp; Citizenship</b> | <b>City</b><br>SANDY                                  | <b>State or Foreign Country</b><br>UTAH | <b>Country of Citizenship</b><br>USA                  |
| <b>Post Office<br/>Address</b>         | <b>Post Office Address</b><br>1731 EAST ALBIN DRIVE   | <b>City</b><br>SANDY                    | <b>State &amp; Zip Code/Country</b><br>UTAH 84092/USA |

1.  Enclosed is a copy of the prior application; including the specification, claims, drawings, oath or declaration showing the applicant's signature, and any amendments referred to in the oath or declaration filed to complete the prior application. (It is noted that no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein.) The continuing application is as follows: 81 pages of specification, 37 claims, 1 pages of abstract, 36 pages of Microfiche Appendix, 12 sheets of drawings, and 22 pages of oath or declaration.

The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

2.  Cancel original claims 1-37 of this application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

3.  The filing fee is calculated below:

CLAIMS AS FILED

| NUMBER FILED                   | NUMBER EXTRA | RATE                     | FEE             |
|--------------------------------|--------------|--------------------------|-----------------|
| <b>TOTAL CLAIMS:</b><br>18     | 0            | x \$18.00                | \$0.00          |
| <b>INDEPENDENT CLAIMS</b><br>2 | 0            | x \$78.00                | \$0.00          |
|                                |              | <b>BASIC FILING FEE:</b> | <b>\$760.00</b> |
|                                |              | <b>TOTAL FILING FEE:</b> | <b>\$760.00</b> |
|                                |              |                          |                 |

A Verified Statement that this filing is by a small entity is already filed in the prior application.

A Verified Statement that this filing is by a small entity is attached.

Payment of fees:  
 Attached is a check in the amount of \$760.00.  
 Please charge Deposit Account No. 13-2725.

The Commissioner is hereby authorized to charge any additional fees as set forth in 37 CFR §§ 1.16 to 1.18 which may be required by this paper or credit any overpayment to Account No. 13-2725.

Amend the specification by inserting before the first line the sentence:  
 "This application is a Continuation of application Serial No. 08/539,413, filed October 5, 1995, which is a Divisional of application Serial No. 08/264,795, filed June 23, 1994, which issued as U.S. Patent No. 5,557,514 on September 17, 1996 application(s) are incorporated herein by reference."

A set of formal drawings (\_\_\_\_ sheets) is enclosed.

8.  Priority of application Serial No. \_\_\_\_\_, filed on \_\_\_\_\_ in \_\_\_\_\_, is claimed under 35 U.S.C. 119.

The certified copy has been filed in prior application Serial No. \_\_\_\_\_, filed \_\_\_\_\_.

9.  The prior application is assigned of record to \_\_\_\_\_ located at \_\_\_\_\_.

10.  The Power of Attorney in the prior application is to:  
 Merchant & Gould P.C.  
 3100 Norwest Center  
 90 South Seventh Street  
 Minneapolis, MN 55402-4131

11.  A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

Date: November 10, 1999

- Fee for excess claims is attached.
- 12.  A petition and fee has been filed to extend the term in the prior application until \_\_\_\_\_. A copy of the petition for extension of time in the prior application is attached.
- 13.  The inventor(s) in this application are less than those named in the prior application and it is requested that the following inventors identified above for the prior application be deleted:
- 14.  Also Enclosed: Statement in Accordance with 37 C.F.R. 1.608(a), Statement of no New Matter Submitted in Substitute Specification, substitute specification, Proposed Change to the Drawings, and Revised Fig. 12
- 15.  Address all future communications to the **Attention of Alan G. Gorman** (may only be completed by attorney or agent of record) at the address below.
- 16.  A return postcard is enclosed.

Respectfully submitted,

MERCHANT & GOULD P.C.  
3100 Norwest Center  
90 South Seventh Street  
Minneapolis, Minnesota 55402  
(612) 332-5300

  
\_\_\_\_\_  
Alan G. Gorman  
Reg. No. 38,472  
AGG:PSTkaw

S/N NEW FILING

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SEARE ET AL. Examiner: UNKNOWN  
Serial No.: NEW FILING Group Art Unit: UNKNOWN  
Filed: HEREWITH Docket No.: 12344.2USC1  
Title: METHOD AND SYSTEM FOR GENERATING STATISTICALLY-BASED MEDICAL PROVIDER UTILIZATION PROFILES

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EL455018055US  
Date of Deposit: November 10, 1999

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By: Linda McCormick

Name: Linda McCormick

JCS42 U.S. PTO  
09/437567  
11/10/99

**STATEMENT OF NO NEW MATTER**  
**SUBMITTED IN SUBSTITUTE SPECIFICATION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Alan G. Gorman, Registration No. 38,472, the attorney for Applicant in conjunction with the above referenced application, along with the substitute specification enclosed herewith, provide the following remarks. The substitute specification does not contain any new matter. The substitute specification reflects the amendments to the specification submitted in the Preliminary Amendment submitted concurrently herewith.

Respectfully submitted,  
Merchant & Gould P.C.  
3100 Norwest Center  
90 South Seventh Street  
Minneapolis, MN 55402  
612/332-5300

Dated: November 10, 1999

  
Alan G. Gorman  
Reg. No. 38,472  
AGG

S/N NEW FILING

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|             |  |                 |             |
|-------------|--|-----------------|-------------|
| Applicant:  | SEARE ET AL.   | Examiner:       | UNKNOWN     |
| Serial No.: | NEW FILING   | Group Art Unit: | UNKNOWN     |
| Filed:      | HEREWITH   | Docket No.:     | 12344.2USC1 |
| Title:      | METHOD AND SYSTEM FOR GENERATING STATISTICALLY-BASED MEDICAL PROVIDER UTILIZATION PROFILES |                 |             |

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EL455018055US  
Date of Deposit: November 10, 1999

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By: Linda McCormick

Name: Linda McCormick

PROPOSED CHANGES TO THE DRAWINGS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Applicants propose to amend Fig. 12 as shown in revised Fig. 12.

Respectfully submitted,

MERCHANT & GOULD P.C.  
3100 Norwest Center  
90 South Seventh Street  
Minneapolis, Minnesota 55402  
(612) 332-5300

Date: November 10, 1999

Alan G. Gorman  
Alan G. Gorman  
Reg. No. 38,472  
AGG:PSTkaw

S/N NEW FILING

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|             |  |                 |             |
|-------------|--|-----------------|-------------|
| Applicant:  | SEARE ET AL.   | Examiner:       | UNKNOWN     |
| Serial No.: | NEW FILING   | Group Art Unit: | UNKNOWN     |
| Filed:      | HEREWITH   | Docket No.:     | 12344.2USC1 |
| Title:      | METHOD AND SYSTEM FOR GENERATING STATISTICALLY-BASED MEDICAL PROVIDER UTILIZATION PROFILES |                 |             |

CERTIFICATE UNDER 37 CFR 1.10:

"Express Mail" mailing label number: EL455018055US  
Date of Deposit: November 10, 1999

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Assistant Commissioner for Patents, Washington, D.C. 20231.

By: Linda McCormick  
Name: Linda McCormick

STATEMENT IN ACCORDANCE WITH 37 C.F.R. 1.608(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Alan G. Gorman, Registration No. 38,472, the attorney for Applicant in conjunction with the above referenced application, along with Preliminary Amendment submitted concurrently herewith provide the following remarks. The present application has a priority filing date of June 23, 1994. In accordance with 37 C.F.R. § 1.601(m) and § 1.608(a), Applicant is the senior party and *prima facie* entitled to judgement of priority with respect to the effective filing date of U.S. Patent No. 5,835,897. I have reviewed U.S. Patent No. 5,835,897 and find that the subject matter claimed, corresponding to the count set forth in the Preliminary Amendment to be patentable under the present application. Accordingly, Applicant is entitled to a judgement relative to the patentee.

Respectfully submitted,  
Merchant & Gould P.C.  
3100 Norwest Center  
90 South Seventh Street  
Minneapolis, MN 55402  
612/332-5300

Dated: November 10, 1999

  
Alan G. Gorman  
Reg. No. 38,472  
AGG